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IN THE

Supreme Court of the United States

OCTOBER TERM, 1967

No. 892

MALVERN M. HASHA AND
INTERNATIONAL TOOL COMPANY, INC.,
Petitioners,

v.

FOSTER CATHEAD COMPANY,
Respondent.

ON PETITION FOR WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

An adequate reference to the opinion of the Court of Appeals below is made in the Petition.

JURISDICTION

The jurisdictional requisites are set forth in the Petition.

CONSTITUTIONAL PROVISION INVOLVED

Respondent believes that no constitutional provision is involved, but if it is, then it is the one set forth in the Petition at page 3.

QUESTIONS PRESENTED

It is respectfully submitted that the following single question, rather than the questions urged by the Petitioners, is the one correctly presented:

> Could the Court of Appeals hold, contrary to a jury finding, that a patent is not infringed where the structures involved in the patent and the alleged infringing structure were relatively simple mechanical devices, differing considerably, and there is no dispute in the record as to their manner of operation.

STATEMENT OF THE CASE

This is a civil action by the Petitioners, Malvern M. Hasha and International Tool Co., Inc., for alleged infringement by the Respondent, Foster Cathead Company, of claims 1, 2, 3, 4, 12, 13, 15, 16 and 17 of United States Letters Patent No. 3,144,085 issued August 11, 1964 for a Power Spinner Unit for Well Swivels. (R. 1112-1114) The trial was to a jury in the District Court which jury held the patent claims valid and all but one infringed. The District Court entered judgment in accordance with the verdict. (R. 1290-1292)

The Court of Appeals for the Fifth Circuit affirmed the judgment of validity and reversed the judgment of infringement. (Petition p. 18a, 29a and 34a) The Petitioners seek a review of the decision of the Court of Appeals in reversing the judgment of infringement.

The device of the patent in suit is used in drilling an oil well and is commonly known in the industry as a "kelly spinner". Respondent has only one form of device alleged to infringe and that is its Model 77 spinner. There is no dispute in the record as to the construction or mode of

operation or results accomplished by either the device of the patent or the Model 77 spinner.

The patent claims alleged to be infringed were admittedly added by Petitioner Hasha after seeing the Respondent's Model 77 spinner and for the express purpose of covering it. Petitioner Hasha used in these claims several broad expressions of "means" to do various things in an attempt to have the claims "literally read on" the Respondent's Model 77 spinner. (Petitioners' Ex. 32, R. 1589, Petition p. 26a, footnote 4)

The Court of Appeals correctly pointed out (and the Petitioners do not attack this in their petition) that a literal reading of such broad claims on an accused device does not establish infringement and for there to be infringement, the Petitioners had the burden of proving that the device of the patent and the accused device are equivalents, that is, they perform substantially the same function in substantially the same way to obtain substantially the same result. (Petition pp. 26a, 27a) The Court of Appeals then stated, in the following words, its right to determine if the jury had incorrectly found infringement:

> "We conclude, from a detailed review of the testimony and the exhibits in the case, that there has been no infringement. *The structures involved in the patent in suit and Foster's Model 77 spinner are relatively simple mechanical devices, and their manner of operation is undisputed.* While infringement is usually a question of fact, that rule is subject to the exception that where, as here, the findings of infringement *vel non,* are based on inferences drawn from exhibits, documents, and uncontradicted testimony, rather than on the conflicting testimony of witnesses whose credibility is for the jury, such findings are subject to full review as questions of law. *Samuelson* v. *Bethlehem Steel Company, supra; Cameron Iron Works* v. *Stekoll,* 5 Cir. 1957, 242 F.2d 17, 21." (Petition p. 27a)[1]

[1] Emphasis throughout is Respondent's unless otherwise indicated.

On the following page, the Court of Appeals pointed out:

> "Viewed in this light there is no infringement because the elements in the structures and the modes of operation are substantially different and the result accomplished is not the same." (Petition p. 28a)

It is language in the portion first quoted above of the decision of the Court of Appeals on which the Petitioners base their Petition.

ARGUMENT

Rule 19, which fixes the standard for granting writs of certiorari, requires there be "special and important" reasons for the writ. None such exist here. This is simply a patent case in which the Court of Appeals found that the undisputed evidence established there was no infringement of the monopoly of the patent and therefore it could and did reverse the judgment of the trial court entered on the jury verdict.

The Petitioners could not have ultimately succeeded in the Court of Appeals even if that court had affirmed the finding of infringement for the Court of Appeals held (Petition p. 27a):

> ". . . The broad language in the claims cannot, however, be construed as Hasha would have us do, *for if the claims be so extended they become invalid for want of sufficient disclosure.* (Citing authority)"

Furthermore, since the Court of Appeals held there was no infringement, it specifically did not pass on certain of Respondent's attacks on validity conditioned on the patent claims being construed broadly enough to be infringed.[2]

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[2] "As we shall later point out, the claims of Hasha's patent are embarrassingly broad and we are unwilling to extend his monopoly far beyond the invention. *Cf. Edwards* v. *Johnston Formation Testing Corporation,* 5 Cir. 1932, 56 F. 2d 49, 50. This pretermits the necessity for an extended discussion of the many pronged attack on validity by Foster premised upon a finding of infringement." (Petition p. 23a)

Petitioners' position appears to be (Petition p. 5) that the Court of Appeals was required to accept the jury's inference or conclusion of infringement even though the evidence on infringement was undisputed and that since the Court of Appeals did not do so, the decision of the Court of Appeals is contrary to decisions of this Honorable Court, especially in negligence cases.

Contrary to Petitioners' position, a patentee is not entitled to a monopoly of whatever scope favorably impresses a jury.[3]

There Is No Conflict Between the Action of the Court of Appeals in Reversing the Jury Finding of Infringement and Applicable Decisions of this Court.

The Court of Appeals stated in its decision:

> "The issue of infringement turns upon a comparison of Hasha's claims with Foster's device and upon the application of the doctrine of equivalents." (Petition p. 25a)

In this situation, the language of the Court of Appeals quoted on pages 3 and 4 hereof is strikingly similar to the language of this Honorable Court in *Singer Mfg. Co.* v. *Cramer,* 192 U.S. 265, 48 L. Ed 437 (1904) where both lower courts were reversed because the defendant's motion for directed verdict for lack of infringement was not granted. That case, like the case at bar, involved the question of equivalents and in its decision, this Honorable Court held:

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[3] In addition to *Singer Mfg. Co.* v. *Cramer,* 192 U.S. 265 (1904) discussed later herein, this Honorable Court in *Black Diamond Coal Manufacturing Co.* v. *Excelsior Coal Co.,* 156 U.S. 611, 618, 39 L. Ed. 553, 555 (1895) held with respect to patent infringement:

> "There was no question to go to the jury in the case, and the Court should have directed a verdict for the defendant."

". . . As in each of the patents in question it is apparent from the face of the instrument that extrinsic evidence is not needed to explain terms of art therein, or to apply the descriptions to the subject-matter, and as we are able, from mere comparison, to comprehend what are the inventions described in each patent, and, from such comparison, to determine whether or not the Diehl device is an infringement upon that of Cramer, *the question of infringement or no infringement is one of law,* and susceptible of determination on this writ of error. (Citing cases)" 192 U.S. at 275, of 48 L. Ed. at 443. * * *

". . . There is no substantial identity in the character of the two devices, unless, by substantial identity, is meant every combination which produces the same effect. The differences between the Diehl device and the Cramer construction are substantial, and not merely colorable." 192 U.S. at 286, 48 L. Ed. at 448.[4]

The paragraph first quoted above from *Singer Mfg. Co.* v. *Cramer* has been referred to with approval in the non-jury patent cases of *Sanitary Refrigerator Co.* v. *Winters,* 280 U.S. 30, 36, 74 L.Ed. 147, 153 (1929) and *United States* v. *Esnault-Pelterie,* 303 U.S. 26, 30, 31, 82 L.Ed. 625, 629 (1938).

The Petitioners' basic problem is that the Court of Appeals obviously decided the evidence on infringement, *vel non,* was so one-sided or overwhelming against infringement that the jury finding of infringement, whether based

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[4] Petitioners seek to distinguish this case (Petition p. 10) on the basis that in *Singer Mfg. Co.* v. *Cramer* the accused device was illustrated in a patent belonging to the defendant there which made comparison with the plaintiff's patent easy. However, in the case at bar the Court of Appeals specifically pointed out that both the patent and defendant's Model 77 spinner ". . . are relatively simple mechanical devices and their manner of operation is undisputed." (Petition p. 27a)

on inference, conclusion or otherwise, simply could not stand. Such a position is not in conflict with the applicable decisions of this Court.

The case of *Richmond & Danville R. Co.* v. *Powers,* 149 U.S. 43, 45, 37 L.Ed. 642, 643 (1893) in the very portion quoted by Petitioners (Petition p. 6) recognizes that for an inference from undisputed facts to be upheld, the inference must be one which "fair-minded men will honestly draw".

In *Gunning* v. *Cooley,* 281 U.S. 90, 94, 74 L.Ed. 720, 724 (1930) cited by Petitioners (Petition p. 6), this Honorable Court stated immediately preceding the portion quoted by the present Petitioners that inferences must be " . . . inferences that fairly are deducible . . . " and in the portion immediately following that quoted by the present Petitioners stated:

> "Where the evidence upon any issue is all on one side or so overwhelmingly on one side as to leave no room to doubt what the fact is, the Court should give a peremptory instruction to the jury. (Citing authority)."

Again, in *Tennant* v. *Peoria & P.U.R. Co.,* 321 U.S. 29, 35, 88 L.Ed. 520, 525 (1944) relied upon by the Petitioners (Petition p. 9), it is stated in the portion quoted by the Petitioners that:

> ". . . The focal point of judicial review is the *reasonableness* of the particular inference or conclusion drawn by the jury."[5]

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[5] Even *Hansen* v. *Safeway Stores,* 283 F. 2d 336 (9th Cir. 1956), the Court of Appeals case relied upon by Petitioners (Petition p. 7), which was a case involving validity rather than infringement, recognizes, ". . . the trial court can set aside the finding and enter a judgment for defendant if there are no grounds for the verdict." (238 F. 2d at 340)

In numerous cases this Honorable Court has held that a court has the right to review the reasonableness of a conclusion or inference made by a jury and set it aside where it is not reasonable. For example, in *Brady* v. *Southern Ry. Co.*, 320 U.S. 476, 479, 88 L.Ed. 239, 243 (1943), a Federal Employers Liability Act case, it was held:

> ". . . When the evidence is such that without weighing the credibility of the witnesses there can be but one reasonable conclusion as to the verdict, the court should determine the proceeding by nonsuit, directed verdict or otherwise in accordance with the applicable practice without submission to the jury, or by judgment notwithstanding the verdict. By such proceeding of the trial the result is saved from the mischance of speculation over legally unfounded claims. (Citing authority)"

In *Pleasants* v. *Fant*, 89 U.S. 116, 122, 22 L.Ed. 780, 783 (1875) this Honorable Court had before it the question of whether or not the evidence established that the defendant was a partner in a firm. With respect to the point raised of foreclosure of a court's right to refuse to submit a case to a jury where the evidence is insufficient to support a verdict, it was stated:

> ". . . Such a proposition is absurd, and accordingly we hold the true principle to be, that if the court is satisfied that, conceding all the inferences which the jury could justifiably draw from the testimony, the evidence is insufficient to warrant a verdict for the plaintiff, the court should say so to the jury."

Southern Pac. Co. v. *Pool*, 160 U.S. 438, 440, 40 L.Ed. 485, 487 (1896) was an action to recover damages for death of the plaintiffs intestate. With respect to whether or not the deceased was guilty of contributory negligence, it was stated:

> ". . . There can be no doubt where evidence is conflicting that it is the province of the jury to determine, from such evidence, the proof which constitutes negligence. There is also no doubt where the facts are undisputed or clearly preponderant that the question of negligence is one of law. (Citing authority)"

Petitioners rely upon *Graver Tank Co.* v. *Linde Air Prod. Co.*, 339 U.S. 605, 609, 94 L.Ed. 1097, 1103 (1950) for the statement that in a patent infringement action, "A finding of equivalence is a determination of fact." Petitioners argue (Petition p. 8) that this matter of equivalence is one for the jury to determine based upon the credibility of the witnesses. However, in the same paragraph of *Graver Tank Co.* v. *Linde Air Prod. Co., supra,* quoted by the Petitioners, this Honorable Court held that a finding of equivalence was subject to the general principles of appellate review and the Court of Appeals here specifically found there was no question of credibility for the jury. As has been pointed out, this Honorable Court in *Singer Mfg. Co.* v. *Cramer,* 192 U.S. 265, 275, *supra* (a jury patent case) and in *Sanitary Refrigerator Co.* v. *Winters,* 280 U.S. 30, 36, *supra* (a non-jury patent case) has held the undisputed evidence can be such that a finding of infringement based on equivalents is reviewable as a matter of law. Also as shown early herein, negligence and similar questions which are normally questions of fact are similarly reviewable where the evidence does not support them.

This case involves merely the dispute between the Petitioners and the Court of Appeals as to whether there was sufficient evidence to support the jury finding of patent infringement in this particular case. It involves no unsettled important principles of law nor conflicts with decisions of this Honorable Court. Surely this case is not one in which there are "special and important reasons" for the granting of a writ of certiorari.

CONCLUSION

WHEREFORE, PREMISES CONSIDERED, Respondent prays that the Petition for Writ of Certiorari be denied.

Respectfully submitted,

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PROOF OF SERVICE

Service of this Brief for the Respondent in Opposition has been made upon Malvern M. Hasha and International Tool Co., Inc., Petitioners, by mailing a copy postage prepaid to Jack W. Hayden, 500 Jefferson Building, Suite 1111, Houston, Texas 77002, this 27th day of December, 1967.

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